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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,072	09/27/2005	Henk Kole	NL030362US	4351

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BRIARCLIFF MANOR, NY 10510

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

MAIL DATE	DELIVERY MODE
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08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,072

Applicant(s)

KOLE ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 3, 5 to 8 and 11 to 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 3, 5 to 8 and 11 to 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/16/07 has been entered.

2. Claims 1 to 3, 5 to 8 and 11 to 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "an organic, polymerizable substituent" is confusing. A substituent will be attached to something, such as a Si atom. In this claim both silane compounds are fully substituted and there is no open valence for an organic polymerizable substituent. As such it is unclear what is embraced by this term.

Note that, as used in the specification, the group Y as defined on page 2 is a polymerizable substituent that is attached to an Si atom.

3. Claims 1 to 3, 5 to 8 and 11 to 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the event that applicants intend the term "an organic, polymerizable substituent" to be an organic polymerizable compound, rather than substituent, the Examiner cannot find support for such a compound in the specification. Reading the phrase "an organic, polymerizable substituent" in this claim, one can consider it to be a compound since the substituent is not bonded to any other compound or atom.

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4. Claims 1 to 3, 5 to 8 and 11 to 15 are objected to because of the following informalities: The word "methyltromethoxysilane" is misspelled. Appropriate correction is required. Also, in claim 6, "dimethylmalonoc" is misspelled.

5. Claims 2, 14 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

For claim 2, this claim does not further limit claim 1 since 1) the organosilane in claim 2 is already limited by the selection in claim 1 and 2) water will necessarily be present in claim 1 since the organosilane composition is hydrolytically condensed. The Examiner notes that this does not apply to the composition in claim 3 since, while the silane of claim 3 is limited by claim 1, the presence of silica is further limiting.

For claims 14 and 15, these claims are not considered to be further limiting since they do not include methyltrimethoxysilane.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 to 3, 5, 6, 8, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Havey et al.

The teachings in Havey et al. were detailed in paragraph 8 of the office action dated 5/9/07, as they applied to claims 13 to 15 at the time. As noted then, the breadth of "medical apparatus" includes the lenses taught by Havey et al.

With this in mind, please see Example 21. In this example, a lens is coated a sol gel composition prepared by hydrolyzing methyltrimethoxysilane, tetraethyl orthosilicate and an epoxysilane (which contains an organic polymerizable substituent). This appears to meet the requirements of claim 1¹. Note that the composition in Example 21 contains silica and itaconic acid, meeting claims 3 and 5 as well. The composition can be cured at room temperature and meets claim 5.

The epoxysilane meets the silane compound in claims 8 and 11.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havey et al.

This rejection relies on the rationale of record. Please see paragraph 8 in the office action dated 5/9/07. This details the obviousness of the specific compositions claimed. Since these claims have not been amended, this rejection is maintained.

10. Claims 1 to 3, 5, 8, 11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Schachter.

The effective filing date of Schachter is 9/24/02, as the entire specification of Schachter is supported by the US provisional application.

Schachter teaches antimicrobial coating compositions for medical articles. See for instance paragraphs 15 to 18 which disclose various articles. The coating compositions of Schachter contain various silanes that hydrolyze to form a coating. While the entire specification in Schachter contains pertinent teachings, particular attention is drawn to paragraph 201 which teaches a coating composition containing an epoxysilane

¹ The Examiner uses the word "appears" only because it is not exactly clear what applicants are claiming.

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(which has an organic polymerizable substituent), methyltrimethoxysilane and a silicate compound (which paragraph 94 teaches is preferably TEOS). This anticipates the coating composition found in claim 1. See also the composition starting on paragraph 224 and paragraph 351. This anticipates claims 1 and 2.

For claim 3, please note paragraph 349 which teaches that silica and/or silicates can be added, anticipating the addition of both silica and TEOS.

The epoxysilane meets the material found in claim 8.

11. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachter.

This rejection rationale is consistent with that noted in paragraph 5 of the office action dated 1/30/07. This reference does not teach a tabletop of a diagnostic system but it does teach a wide variety and non-limiting selection of medical devices that can be coated with the composition therein. The coating composition provides improved antibacterial properties. See the various benefits found on paragraphs 356 and 357. The skilled artisan would realize that a tabletop of a diagnostic system quite frequently comes into contact with the human body and should be free of germs. Thus it would have been obvious to use the coating composition of Schachter to coat such a tabletop in an effort to take advantage of the antibacterial properties associated therewith.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schachter as applied to claim 1 above, and further in view of Shoup et al.

Schachter teaches the general use of organic acids (paragraph 249) but does not teach an acid within claim 6.

In a similar composition, Shoup et al. teach that the addition of acids such as malonic or itaconic acid not only provides hydrolysis but also provides stability to the coating solution as well as enhancing abrasion resistance (paragraph 43).

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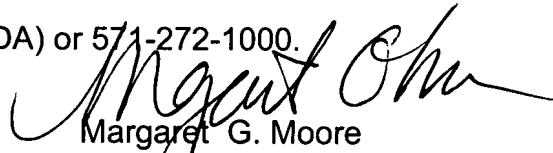
Thus one having ordinary skill in the art would have been motivated to use a malonic or itaconic acid in the composition of Schachter in an effort to take advantage of the benefits and properties thereof.

13. Please note that each of the references applied supra have already been cited in this application on previous PTO-892 forms.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
8/22/07